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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,272	03/12/2001	Randolph A. Fry		8549
27870	7590	09/22/2004		
RANDOLPH FRY 967 RICHARD LANE DANVILLE, CA 94526			EXAMINER NGUYEN, MAIKHANH	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 09/22/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,272

Applicant(s)

FRY, RANDOLPH A.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application is responsive to the following communications: original application filed 03/12/2001.
2. Claims 1-10 are currently pending in this application. Claims 1 and 6 are independent claims.
3. It is noted that the relationship between the instant application and the references cited by Applicant in "Cross Reference To Related Applications" (page 1) is unclear. Applicant is advised to clarify their relationship. The double patenting rejection below occurs because of the assumption that U.S. Patent **6,108,656** and the instant application have a common ownership. The Examiner considers the references cited in "Cross Reference To Related Applications" (page 1) as background of the invention. Please delete "Cross Reference To Related Applications."

Specification

4. The abstract of the disclosure is objected to because it exceeds the limit of 150 words. Correction is required. See MPEP § 608.01(b).
5. The claims are object to because each element or step of the claim is not separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. **6,108,656** (filed 05/1999) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Claim 1 of the instant application recites the limitations:

- a) encoding a human readable data string comprising a file into a machine readable symbol;
- b) rendering said machine readable symbol within a data carrier;
- c) transferring an input data string from said machine readable symbol with a computer input device coupled to said computer;
- d) parsing said input data string to determine said file name;
- e) utilizing said file name to request the computer file designated thereby, by assembling a computer file transfer request expression (string) comprising said file name, and transmitting said computer file transfer request expression to a local server on the computer;
- f) said local server receiving said computer file transfer request expression; and
- g) said local server transmitting a computer file to said client computer in response thereto.

Claim 1 of the U.S Patent No. 6,108,656 recites the limitations:

- a) encoding a symbol data string comprising a file location pointer into a machine readable symbol;
- b) rendering said machine readable symbol within a data carrier;
- c) transposing an input data string from said machine readable symbol with a computer input device coupled to said client computer;
- d) parsing said input data string to determine said file location pointer;
- e) utilizing said file location pointer to request the computer file designated thereby, by assembling a computer file transfer request word comprising said file location pointer, and

transmitting said computer file transfer request word to a target server computer via a computer network system;

f) said target server computer receiving said computer file transfer request word; and

g) said target server computer transmitting a computer file to said client computer in response thereto.

The examiner can ascertain no difference between the claims of the instant application and the Pat. No. 6,108,656. It is noted that the minor difference encompass replacement of the recitations of the limitations in the claims and it appears to be substantially the same or duplicate or in some instances obvious over one another.

As to the remaining claims 2-10, they are also rejected under obvious type double patenting as stated in claim 1 above.

Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by **Dust et al.** (U.S. 5,933,829, issued 08/1999).

As to independent claim 1, Dust teaches a method for an isolated computer to retrieve and display a computer file (*Abstract*) comprising the steps of:

- encoding a human readable data string comprising a file name into a machine readable symbol (*e.g., a file ...is encoded into a machine readable symbol; col.2, lines 43-44/col.3, lines 14-18 and col.10, lines 22-23*);

- rendering the machine readable symbol within a data carrier (*e.g., the machine readable symbol is rendered within a data carrier; col.2, lines 44-46 and col.10, lines 24-25*);

- transferring an input data string from the machine readable symbol with a computer input device coupled to the computer (*e.g., a computer input device such as two-dimensional bar code scanner is coupled to the client computer and transposes an input data string from the machine readable symbol; col.2, lines 47-53 and col.10, lines 26-28*);

- parsing the input data string to determine the file name (*e.g., the computer parses the input data string to determine the file; col.2, lines 50-51 and col.10, lines 29-30*);

- utilizing the file name to request the named computer file (*e.g., the file ... may be utilized to request the computer file; col.2, lines 54-63 and col.10, lines 31-32*), by assembling a computer file transfer request expression comprising the file name (*e.g., assembles a computer transfer request word including the file; col.2, line 63-col.3, line 13 and col.10, lines 53-54*);

- transmitting the computer file transfer request expression to a local server on the computer (*e.g., transmits the request word to a target server computer over a computer network system; col.2, lines 64-67 and col.10, lines 55-57*);

- the local server receiving the computer file transfer request expression (*e.g., the target server computer receives the computer file transfer request word; col.3, lines 12-14 and col.10, lines 59-60*);

- the local server transmitting a computer file to the computer in response thereto (*e.g., the target server ... transmits a computer file to the client computer in response thereto; col.3, lines 11-13 and col.11, lines 6-7*); and

- the computer displaying the computer file (*e.g., the file is then displayed to the user; col.9, lines 4-27*).

As to dependent claim 2, Dust teaches the computer is connected to the Internet (*e.g., the computer is interconnected to a computer network; col.12, lines 65-66*), and wherein the request expression is directed towards a target server computer in communication with the Internet (*e.g., the computer file transfer request word is directed towards a target server computer in communication with the Internet; col.10, lines 58-61*).

As to dependent claim 3, Dust teaches the computer is connected to an intranet, and wherein the request expression is directed towards a target server computer on the afore-mentioned intranet (*col.2, lines 64-col.3, line 13*).

As to dependent claim 4, Dust teaches the request expression includes a uniform resource locator for specifying a target server in communication with the Internet (*e.g., said file location pointer comprises a uniform resource locator for specifying a file on the target server computer in communication with the Internet; col.10, lines 62-65*).

As to dependent claim 5, Dust teaches the request expression includes a network address for specifying a target server on the intranet (*e.g., word including the file location pointera target server computer ...the Internet ... or intranet; col.2, line 64- col.3, line 13*).

As to independent claim 6, the rejection of independent claim 1 above is incorporated herein in full. Additionally, claim 6 further recites “a characteristic digital sample”.

Dust teaches a characteristic digital sample (*e.g., the symbol 12; col.4, lines 51-67 and Fig.12*).

As to dependent claims 7-10, they include the same limitations as in claims 2-5, and are similarly rejected under the same rationale.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Li et al.	U.S Patent No. 5,644,408	issued: Jul. 1, 1997
Wolf et al.	U.S Patent No. 5,671,282	issued: Sep. 23, 1997
Bloomberg	U.S Patent No. 5,765,176	issued: Jun. 9, 1998
Wilz, Sr. et al.	U.S Patent No. 6,076,733	issued: Jun. 20, 2000
Durst, Jr. et al.	U.S Patent No. 6,434,561	issued: Aug. 13, 2002

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. After mid-October, 2004, the examiner can be reached at (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (703) 305-9792.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
September 20, 2004


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER